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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,967	05/21/2007	Gordon Layard	LAYARD01	8705
7550 Gordon Layard 14 Myola Road Newport Beach NSW, 2106 AUSTRALIA			EXAMINER SMITH, BENJAMIN J	
			ART UNIT 2176	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/597,967

**Applicant(s)**

LAYARD ET AL.

**Examiner**

Benjamin J. Smith

**Art Unit**

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Applicant's Response***

In Applicant's Response dated 12/15/2008, Applicant amended Claims 1, 4, 5 and 13, and argued against all objections and rejections previously set forth in the Office Action dated 10/30/2008.

Based on the amendments, the objections to the Specification previously set forth are withdrawn.

Based on the amendments and arguments the objections to the claims previously set forth are withdrawn.

Based on the arguments the rejections of Claims 1-18 under 35 U.S.C. 101 previously set forth are maintained.

Based on the arguments the prior art rejection of Claims 1-18 under 35 U.S.C. 102 and 103 previously set forth are maintained.

The examiner would appreciate the applicant noting where the support for amendments is located in the specification.

***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The phrase "discrete *electronic screens*" is used in Claims 1-18. This phrase is not disclosed in the specification and does not have a common meaning to one in the art. An amendment should be made or a definition should be given to allow for proper claim interpretation.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4 and 5 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims were amended to add the phrase "prescribed to begin" which is not found in the specification.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

*Claim 1:*

In summary, Claim 1 recites a "*system*" solely comprising a "function to import" and a "function to analyse". An embodiment of the "function to import" and a "function

to analyse" is simply a piece of software, as described in the Specification (see paragraph 0034). Thus, the recited "*system*" is software per se. That is, the recited "*system*" is not a process, a machine, a manufacture or a composition of matter.

Accordingly, Claim 1 fails to recite statutory subject matter as defined in 35 U.S.C. 101.

Claims 2-18 merely recite additional features of the "function to import" and a "function to analyse". Thus, Claims 2-18 do not further define the recited "*system*" as being within a statutory process, machine, manufacture or composition of matter.

Accordingly, Claim 2-18 fails to recite statutory subject matter as defined in 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 7-12, 14-15 and 17-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. US Patent No. 6,315,572 (Hereinafter, "Owens") in view of Wolff et al. US Publication No. 2004/0076342 (hereinafter, "Wolf").

**Claim 1:**

Owens discloses:

*A software system for use in creating electronic screen based product, said system comprising:*  
*a function to import source documents, and automatically process them, without the requirement for any user tagging within said documents, into a plurality of discrete electronic screens, which collectively form an electronic screen based product [col. 20, lines 33-43 and figs. 11-13] [takes data available in the lesson, imported document, and generates questions, or screen based products, from the data which are displayed on screens without the preparer generating questions]; and*  
Owens also disclosed automatically generating questions with images [fig. 12]

Owens fails to disclose:

*a function to analyse the text of each said discrete electronic screen and then cross reference that text with metadata associated with images found in a collection of photographic and/or clip art files, automatically inserting a selected matching image into said analysed electronic screen.*

Wolff discloses:

*a function to analyse the text of each said discrete electronic screen and then cross reference that text with metadata associated with images found in a*

*collection of photographic and/or clip art files, automatically inserting a selected matching image into said analysed electronic screen* [paragraph 0066, lines 1-16]  
[metadata associated with an image is identified and matched to text and inserted if there is a match].

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the image to text matching in Wolf with the method of question generation using images in Owens.

The combination would have been useful to create better questions where the learner didn't associate a word with a specific image, but with the general look of an object.

**Claim 2:**

Owens discloses *wherein, based on system defaults or user selection, existing source document media are incorporated by the system into said electronic screens* [col. 11, lines 8-19] [author selects the lesson material to incorporate].

**Claim 7:**

Owens discloses *wherein end user navigation of said discrete electronic screens is facilitated by predefined, user selected navigational interfaces or schemes* [col. 10, lines 62-66] [GUI with navigational components and pages].

**Claim 8:**

Owens discloses *wherein a user menu electronic screen is automatically generated which provides end user access to the topics contained within said electronic screen based product* [col. 21, lines 49-54] [automatically generate regions for questions to be answered].

**Claim 9:**

Owens discloses *wherein said electronic screens, can be edited using a graphical user interface included within the system and where additional electronic screens, text, graphics and other media can be added and manipulated* [col. 14, lines 21-30] [add a category, add object, import object all through icons].

**Claim 10:**

Owens discloses *wherein any hierarchical relationship that exists between said electronic screens can be manipulated, in terms of end user navigation, using a graphical user interface included within the system* [col. 11, lines 1-19] [edit of hierarchical information including object links].

**Claim 11:**

Owens discloses *wherein said discrete electronic screens, collectively forming an electronic screen based product is published by the system for use on a stand alone*



*computer or a local area network* [col. 25, lines 27-35] [implemented as a computer system].

**Claim 12:**

Owens discloses *wherein said discrete electronic screens, collectively forming an electronic screen based product is published by the system for use on a web server for internet or intranet use* [col. 25, lines 27-35] [may be transmitted on a network or internet connection].

**Claim 14:**

Owens discloses *wherein said published electronic screen based product communicates end user progress and performance to a database which can be referenced by said published electronic screen based product itself and by the courseware designer, and anyone who has been provided with the appropriate access* [col. 16, lines 58-65] [wide variety options for displaying scoring information including availability to the instructor or teacher, these are people that have the appropriate access].

**Claim 15:**

Owens discloses *wherein said published electronic screen based product communicates end user progress and performance to a database which can be referenced by said published electronic screen based product itself and by the*

*courseware designer, and anyone who has been provided with the appropriate access* [col. 16, lines 58-65] [wide variety options for displaying scoring information including availability to the instructor or teacher, these are people that have the appropriate access].

**Claim 17:**

Owens discloses *wherein the system processes said source documents into said discrete electronic screens by sending commands and data to a predefined third party presentation slideshow authoring system* [col. 13, lines 30-33] [slideshow presentation can be made, if the slide show can be incorporated into the method then it must receive commands to do so].

**Claim 18:**

Owens discloses *wherein the format of said discrete electronic screens produced are compatible with and can be edited by a predefined third party presentation slideshow authoring system* [col. 13, lines 30-33] [slideshow presentation can be made, the format would have to be compatible if the slide show is presented, it also may be converted into a different format and still be compatible].

Claims 3-5 rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. US Patent No. 6,315,572 (Hereinafter, "Owens") in view of Wolff et al. US Publication No. 2004/0076342 (hereinafter, "Wolf") and further in view of Anderson US Publication No. 2004/0102958 (hereinafter, "Anderson").

**Claim 3:**

Owens and Wolff disclose all the claimed elements of Claim 1 as shown above.

Owens and Wolff fail to disclose:

*wherein the nature of said discrete electronic screens are determined by user selected or system default templates, fonts, and image types, sizes and categories.*

Anderson discloses:

*wherein the nature of said discrete electronic screens are determined by user selected or system default templates, fonts, and image types, sizes and categories* [paragraph 0010, lines 1-10 and paragraph 0193] [files may created based on user defined rules or templates, font and icons, which are images].

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the image to text matching in Wolf and the method of question generation using images in Owens with the method of document division in Anderson.

The combination would have been useful to create different lessons segmented by the given options which would then be used for the generation of questions.

**Claim 4:**

Anderson discloses *wherein new discrete electronic screens are prescribed to begin, based on user selected or system defaults, when the system encounters page breaks within the source document* [paragraph 0028, lines 9-11] [files segmented into documents by page breaks].

**Claim 5:**

Anderson discloses *wherein new discrete electronic screens are prescribed to begin, based on user selected or system defaults, when the system encounters predetermined heading styles within the source document* [paragraph 0028, lines 9-11] [files segmented into documents by headings].

Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. US Patent No. 6,315,572 (Hereinafter, "Owens") in view of Wolff et al. US Publication No. 2004/0076342 (hereinafter, "Wolf") and further in view of Coniam HKJAL Vol. 3, No. 1, June 1998 pp 41-60 (hereinafter, "Coniam").

**Claim 6:**

Owens and Wolff disclose all the claimed elements of Claim 1 as shown above.

Owens and Wolff fail to disclose:

*wherein paragraphs or sentences, determined by system defaults or user settings, from said discrete electronic screens, are automatically converted into interactive cloze activities.*

Coniam discloses:

*wherein paragraphs or sentences, determined by system defaults or user settings, from said discrete electronic screens, are automatically converted into interactive cloze activities* [page 44, "The process of 'converting' English language texts into multiple-choice cloze tests"] [generation of cloze tests using word frequency and word tagging from a text].

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the image to text matching in Wolf and the method of question generation using images in Owens with the method of cloze creation in Coniam.

The combination would have been useful to create different lessons segmented by the given options which would then be used for the generation of questions.

Claims 13 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. US Patent No. 6,315,572 (Hereinafter, "Owens") in view of Wolff et al. US Publication No. 2004/0076342 (hereinafter, "Wolf") and further in view of Doty US Publication No. 2003/0152904 (hereinafter, "Doty").

**Claim 13:**

Owens and Wolff disclose all the claimed elements of Claim 1 as shown above.

Owens and Wolff fail to disclose:

*wherein said discrete electronic screens, collectively forming an electronic screen based product is published by the system for use on a sharable content object reference model compliant learning management system.*

Doty discloses

*wherein said discrete electronic screens, collectively forming an electronic screen based product is published by the system for use on a sharable content object reference model compliant learning management system [paragraph 0154, lines 1-16] [adhering to SCORM standards allow the content from different vendors to be packaged into a single course].*

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the image to text matching in Wolf and the method of question generation using images in Owens with the method of document compliance in Doty.

The combination would have been useful to enable the packaging of content from different vendors into a single course.

**Claim 16:**

Owens discloses *wherein said published electronic screen based product communicates end user progress and performance to a database which can be referenced by said published electronic screen based product itself and by the courseware designer, and anyone who has been provided with the appropriate access* [col. 16, lines 58-65] [wide variety options for displaying scoring information including availability to the instructor or teacher, these are people that have the appropriate access].

***Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

2004/0014013

Interface for a Presentation System      Diesel, Michael E. et al.

***Response to Arguments***

Applicant's arguments filed 12/15/2008 have been fully considered but they are not persuasive.

**35 USC 101:**

The recitation of "electronic screens" in the claims does not mean the system is necessarily embodied on hardware. System claims must include a hardware component. As currently worded, Claim 1 does not include a hardware component.

**35 USC 103:**

The applicant argues that it is wrong to include the creation of questions in the analysis of Claim 1 and that the Owens reference includes a painstaking step of setting up a document and the present invention does not.

The examiner disagrees.

Owens imports a document, whether painstaking or not, automatically processes the document and then creates a plurality of screens, or questions.

**Claim 1:**

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., see figure on page 2 or applicants response) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).



The applicant makes convincing arguments why the present invention is not obvious, however most of these arguments, or elements, are not recited in the claims. The applicant should include these elements in the claims so they can be properly considered.

The applicant argues that Wolff's system does not disclose associating text analysis with image metadata.

The examiner disagrees.

Wolff discloses image text matching in paragraphs 0064-0066. The system associates the metadata in an image of a car with the request for an image of a car.

**Claim 2:**

The applicant argues that Owens only describes the structure that a text document must have.

The examiner disagrees.

Owens discloses documents included by user selection. The applicant appears to be referring to "document media" as "images, video and audio files". However these items are not claimed and a definition for "document media" is not given in the specification.

**Claim 3:**

The applicant argues that Anderson does a system for generating templates.

The examiner disagrees.

Anderson discloses a system for generating text templates, (see abstract and paragraphs 0011-0016)

**Claim 6:**

The applicant argues that Coniam is irrelevant to the present invention, because Coniam is related to question generation based upon word frequency and it is not totally automated.

The examiner disagrees.

It is the combination of Coniam, with Owens and Wolff that teach the applicants invention. The combined references disclose the invention as claimed, the applicant has not set forth in the claims their system of automatic generation in a unique enough way to distinguish it from the prior art, therefore the references disclose the claim.

**Claim 13:**

The applicant argues that the invention is not unique in being SCORM compliant, but the invention is unique in that it is a fully automatic system that is able to produce SCORM compliant software.

The examiner disagrees.

It is the combination of Doty, with Owens and Wolff that teach the applicants invention. The combined references disclose the invention as claimed, the applicant has

not set forth in the claims their system of automatic generation in a unique enough way to distinguish it from the prior art, therefore the references disclose the claim.

**General Notes on References:**

In response to applicant's argument that the references used are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin J. Smith whose telephone number is (571) 270-3825. The examiner can normally be reached on Monday through Friday 8:30AM-5:00PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin J. Smith/  
Examiner, Art Unit 2176

/DOUG HUTTON/  
Supervisory Patent Examiner, Art Unit 2176